

Remarks

It is noted, for the record, that this a fifth non-final official action! The Applicants hereby object to the piecemeal prosecution which this application is being subjected to. In the most recent official action, the Examiner asserts that the Examiner of record has changed (again) and therefore the present Examiner is allegedly not bound by whatever prior art rejections occurred heretofore. With all due respect to the Examiner, the Applicants disagree. It is noted that Mr. Thomas Pham, the Examiner in charge of this application, is also the Examiner who issued the official action dated July 7, 2003.

This piecemeal prosecution violates the rules of practice, which require the Examiner to cite the best references at his command. Since the Examiner could have cited Humphries in the official action dated July 7, 2003, citing Humphries later on, where not required because of any amendment made by Applicants, evidences piecemeal prosecution.

If the Patent Office is not prepared to issue a patent on this application, then the Patent Office is respectfully requested to issue a final rejection so that the Applicant has the right of taking this matter on Appeal.

Turning to the prior art rejections set forth in the latest official action, the Examiner asserts that claims 1, 6, 15, 21 and 26 are unpatentable over Humphries (US Patent No. 5,621,662) in view of Lee (US Patent No. 5,631,698). This grounds for rejection is respectfully traversed.

The Examiner notes that Humphries fails to teach a number of limitations of the claims but goes on to assert that it would somehow be obvious to combine Humphries with Lee. The Examiner asserts that it would be obvious to a person of ordinary skill in the art to incorporate the OSD of Lee with the independent watchdog circuit of Humphries in addition to the dialing capability thereof because "it would provide for a visual notification of hardware failure to the user on the OSD and remotely alert for service via dialing method."

This alleged motivation for combining the two references is very interesting but is not based upon the disclosure of either of the two prior art references. First, where does the notion of a "hardware failure" arrive from either Lee or Humphries? It is noted that Applicants' own specification refers to a hardware failure. See, for example, page 1, line 15. But, does the term "hardware failure" appear in either of the prior art references cited by the Examiner, or is the Examiner using Applicants' own disclosure against Applicants? It is submitted, with all due respect to the Examiner, that the Examiner is using Applicants' own disclosure against Applicants since the notion of a visual notification in response to a hardware failure is a concept which comes out of Applicants' own patent application and not from the prior art.

With all due respect to the Examiner, it is illegitimate to use Applicants' own disclosure as motivation for trying to combine the prior art references.

Looking at the prior art references in even greater detail, it is noted that Humphries teaches a specific implementation of a watchdog circuit in Figure 8. The watchdog circuit attaches to the serial port of a computer. The watchdog circuit periodically monitors the host computer to verify that the home automation system remains active. If the system fails to indicate that the computer is still on line, then the watchdog timer can initiate a telephone call over the telephone to an offsite location for the purposes of indicating that this system is not active. See Humphries at column 8, lines 48-54.

It is submitted that the watchdog timer of Humphries is responsive to a situation where power goes out to the home and therefore the home automation system has become inactive. The watchdog timer makes note of this (as the computer is then offline) and reports the power outage to an offsite telephone number. Of course, there is no need to report the power outage to the display of the local computer since it is, after all, similarly without power. Note that the watchdog system is powered by a backed-up supply which is independent of the power supply to the rest of the system. See column 9, lines 5-7 of the citation. Clearly, Humphries is capable of placing an offsite telephone call in response to the power going out in the home of the user thereof. However, there is absolutely no need to send any sort of signal to the display to indicate the power has

gone out when the display itself has no power. Moreover, it is submitted that for ordinary humans living in ordinary houses, they do not need to go to a computer having a display with OSD capability (which is probably offline) in order to figure out that the power is out in the house.

It is submitted that the only reason that the Examiner is making the proposals the Examiner does in the official action in combining these two references is a motivation on the part of the Examiner to develop some sort of theory for combining these two references. However, it is submitted, that to a person of ordinary skill in the art who is presented with these two references and who have not had the privilege of reading Applicants' own patent application, would certainly not make the suggestions that the Examiner makes in the official action regarding the alleged obviousness of combining the two references. If the Examiner is going to continue to contend that the watchdog circuit of Humphries will provide some sort of a notification of hardware failure, the Examiner is respectfully requested to put his contentions into Affidavit form since the Examiner appears to be relying on facts which are not set forth in Humphries. It is noted, for the record, that the Applicants' have the privilege of demanding that such evidence be submitted in Affidavit form, according to the rules of practice, and the Applicants hereby make that request, again, with all due respect to the Examiner.

Since all of the prior art rejections rely upon an alleged combination of at least Humphries and Lee, all of the prior art rejections should be withdrawn, as having been made improvidently, in view of a lack of any cogent rationale for combining Lee and Humphries in the manner suggested by the Examiner.

Turning to the Examiner's assertion on page 5 of the official action, the Examiner asserts that "Humphries and Lee teach the communication process having OSD capabilities..." With all due respect to the Examiner, Humphries and Lee do not teach any communication process having OSD capabilities! Lee teaches a self-diagnosing television receiver. It has an OSD unit which provides patterns indicative of an abnormal state of the tv receiver, the current channel number, the current time and the like. Why would a person of ordinary skill in the art connect the television receiver of Lee to the host

computer 20 shown in Figure 3 of Humphries? As already indicated above, there would be no motivation to connect it to the watchdog timer 22, as previously asserted by the Examiner and it is not all clear why there would be motivation to even connect the tv to the host computer 20 of Humphries. As is well known in the art, host computers have perfectly fine monitors and many of those monitors have OSD capabilities. But why try to connect the host computer to a television receiver? What is the advantage or motivation for doing that?

It is submitted that the Examiner is using Applicants' claims as a roadmap for cutting and pasting the prior art together in ways which are completely inconsistent with the teaching of the prior art. The Examiner is, in effect, using Applicants' own disclosure against Applicants. The true test of obviousness, is what does the prior art teach by itself without reference to Applicants' own disclosure. Does it teach or suggest the claims active in this application? Certainly not!

Reconsideration is respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents

POB 1450, Alexandria, VA 22313-1450 on

April 30, 2004

(Date of Deposit)

Corinda Humphrey

(Name of Person Signing)

Corinda Humphrey

(Signature)

April 30, 2004

(Date)

Respectfully submitted,


Richard P. Berg
Attorney for Applicants
Reg. No. 28,145
LADAS & PARRY
5670 Wilshire Boulevard, Suite 2100
Los Angeles, California 90036
(323) 934-2300